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CAESAR RIVISE

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001

SEP 25 2007

118
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
PATENT EXAMINING OPERATION

Applicant(s): Yuan Min WU et al.

Serial No: 09/083,410

Filed: May 22, 1998

Att. Docket No.: E1047/20006

Confirmation No.:

Patent No. 6,046,004

Issued: April 4, 2000

For: SOLUTION HYBRIDIZATION OF NUCLEIC ACIDS WITH ANTISENSE
PROBES HAVING MODIFIED BACKGROUND

RENEWED PETITION UNDER 37 CFR 1.28(c)

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United States Patent and Trademark Office

Office of Petitions

ATTN: Paul Shanoski, Senior Attorney

Via Facsimile to 571-273-8300

SEP 28 2007

OFFICE OF PETITIONS

Sir:

According to the September 17, 2007 Decision on Petition, Patentee's request for acceptance of a fee deficiency was denied for the following reason:

Petitioner has failed to identify both the small entity fee that was actually paid, and when the small entity fee was actually paid.

Favorable reconsideration of the request is respectfully requested in view of the following remarks.

The July 30, 2007 document entitled "RESUBMISSION OF DOCUMENTS AND NOTIFICATION OF ENTITLEMENT TO SMALL ENTITY STATUS" explained:

On December 1, 2004, Patentee notified the PTO that it was withdrawing its claim to small entity status and authorized the PTO to charge Patentee \$495.00 for the deficiency in payment of the 3½ maintenance fee. Copies of the December 1, 2004 Correction of Small Entity Status and Facsimile Receipt are submitted herewith. [Emphasis added.]

Adjustment date: 12/11/2007 CKHLOK
08/02/2007 MBANGURA 00000063 030075 6046004
01 FC:1559 495.00 CR

12/11/2007 CKHLOK 00000017 030075 6046004
01 FC:1559 495.00 DA

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Application No. 09/224,505
Renewed Petition Dated September 25, 2007
Reply to September 17, 2007 Decision on Petition

SEP 25 2007

The December 1, 2004 Correction of Small Entity Status, which was resubmitted to the PTO along with the July 30, 2007 Resubmission, identified both the small entity fee that was actually paid, and when the small entity fee was actually paid using the following table:

| Erroneous Fee | | | Current Fee | Deficiency Owed |
|-----------------|----------|----------|-------------|-----------------|
| Type | Date | Amount | | |
| Maintenance Fee | 05-28-03 | \$445.00 | \$940.00 | \$495.00 |

Accordingly, the original December 1, 2004 request for acceptance of a fee deficiency was compliant with 37 CFR 1.28(c), should have been granted when originally filed, should have been granted when resubmitted July 30, 2007 and should be granted now.

Respectfully submitted,

CAESAR, RIVISE, BERNSTEIN,
COHEN & POKOTILOW, LTD.

By 

David M. Tener
Registration No. 37,054
Customer No. 03000
(215) 567-2010
Attorneys for Patentee

September 25, 2007

Please charge or credit our Account No. 03-0075 as necessary to effect entry and/or ensure consideration of this submission.

Electronic Acknowledgement Receipt

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| | | |
|--------------------------------------|------------------------------|---|
| EFS ID: | 2025720 | SEP 28 2007 |
| Application Number: | 09083410 | OFFICE OF PETITIONS |
| International Application Number: | | |
| Confirmation Number: | 3971 | |
| Title of Invention: | | SOLUTION HYBRIDIZATION OF NUCLEIC ACIDS WITH ANTISENSE PROBES HAVING MODIFIED BACKBONES |
| First Named Inventor/Applicant Name: | YUAN MIN WU | |
| Customer Number: | 3000 | |
| Filer: | David M. Tener/Barb McGregor | |
| Filer Authorized By: | David M. Tener | |
| Attorney Docket Number: | E1047/20006 | |
| Receipt Date: | 30-JUL-2007 | |
| Filing Date: | 22-MAY-1998 | |
| Time Stamp: | 16:30:48 | |
| Application Type: | Utility under 35 USC 111(a) | |

Payment information:

| | |
|------------------------|----|
| Submitted with Payment | no |
|------------------------|----|

File Listing:

| Document Number | Document Description | File Name | File Size(Bytes) /Message Digest | Multi Part /.zip | Pages (if appl.) |
|-----------------|-------------------------------|---|--|------------------|------------------|
| 1 | Miscellaneous Incoming Letter | Notification_of_Loss_Entityment_SE_Status.pdf | 185084 e1a861e64237da9468e9c8b251ddb657 25cd4491 | no | 4 |

Warnings:

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This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
PATENT EXAMINING OPERATION

Applicant(s): Yuan Min WU et al.

Serial No: 09/083,410

Group Art Unit: 1634

Filed: May 22, 1998

Examiner: A. Marschel

Att. Docket No.: E1047/20006

Confirmation No.:

Patent No. 6,046,004

Issued: April 4, 2000

For: SOLUTION HYBRIDIZATION OF NUCLEIC ACIDS WITH ANTISENSE
PROBES HAVING MODIFIED BACKGROUND

**RESUBMISSION OF DOCUMENTS AND NOTIFICATION OF
LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS**

United States Patent and Trademark Office
Maintenance Fee Branch, Office of Finance
ATTN: George Allen
Via EFS-Web & Facsimile to 571-273-6500

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SEP 28 2007

OFFICE OF PETITIONS

Sir:

In preparing to pay the 7½ year maintenance fee using the PTO's finance online shopping page, Patentee found that its status does not appear to have been updated from small to large. On December 1, 2004, Patentee notified the PTO that it was withdrawing its claim to small entity status and authorized the PTO to charge Patentee \$495.00 for the deficiency in payment of the 3½ maintenance fee. Copies of the December 1, 2004 Correction of Small Entity Status and Facsimile Receipt are submitted herewith. Mr. George Allen of the PTO Finance Office today confirmed that the \$495.00 charge was never made against our account.

Patentee hereby requests the PTO to enter the December 1, 2004 Correction, charge the \$495.00 deficiency to Account No. 03-0075, and change Patentee's status to large so that the 7½ year maintenance fee can be paid online. Should there be any questions or concerns regarding this matter, please contact the undersigned at the telephone number listed below.

Respectfully submitted,

CAESAR, RIVISE, BERNSTEIN,
COHEN & POKOTILOW, LTD.

By


David M. Tener
Registration No. 37,054
Customer No. 03000
(215) 567-2010
Attorneys for Patentee

July 30, 2007

Please charge or credit our Account
No. 03-0075 as necessary to effect
entry and/or ensure consideration of
this submission.

*** TX REPORT ***

TRANSMISSION OK

| | |
|----------------|-------------|
| TX/RX NO | 1269 |
| CONNECTION TEL | 17033085077 |
| SUBADDRESS | |
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| ST. TIME | 12/01 12:36 |
| USAGE T | 00'40 |
| PGS. SENT | 4 |
| RESULT | OK |

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
PATENT EXAMINING OPERATION

PATENT

Applicant(s): Yuan Min WU et al.

Serial No: 09/083,410

Group Art Unit:

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Filed: May 22, 1998

Examiner:

SEP 28 2007

Att. Docket No.: E1047/20006

Confirmation No.:

OFFICE OF PETITIONS

Patent No. 6,046,004

Issued: April 4, 2000

For: SOLUTION HYBRIDIZATION OF NUCLEIC ACIDS WITH ANTISENSE
PROBES HAVING MODIFIED BACKGROUNDCORRECTION OF SMALL ENTITY STATUS UNDER 37 CFR 1.28(c)

Mail Stop: M Correspondence
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Patentees have recently become aware of information suggesting that they lost their entitlement to claim small entity status in this matter as a result of a May 22, 2003 sublicense from Genetic Diagnostics, Inc., a small entity licensee of the assignee, to a large entity sublicensee, CML Healthcare, Inc. The erroneous payments were made in good faith by Patentees, and are being corrected promptly after discovery by Patentees of the apparent loss of small entity status.

Accordingly, Patentees submit this paper to update their status and pay the deficiency owed for fees erroneously paid at the small entity rate since May 22, 2003. The following table shows the erroneous fee(s) paid at the small entity rate that should have been paid at the large

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
PATENT EXAMINING OPERATION**

Applicant(s): Yuan Min WU et al.

Serial No: 09/083,410

Group Art Unit:

Filed: May 22, 1998

Examiner:

Att. Docket No.: E1047/20006

Confirmation No.:

Patent No. 6,046,004

Issued: April 4, 2000

For: **SOLUTION HYBRIDIZATION OF NUCLEIC ACIDS WITH ANTISENSE
PROBES HAVING MODIFIED BACKGROUND**

CORRECTION OF SMALL ENTITY STATUS UNDER 37 CFR 1.28(c)

Mail Stop: M Correspondence
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

RECEIVED

SEP 28 2007

Sir:

OFFICE OF PETITIONS

Patentees have recently become aware of information suggesting that they lost their entitlement to claim small entity status in this matter as a result of a May 22, 2003 sublicense from Genetic Diagnostics, Inc., a small entity licensee of the assignee, to a large entity sublicensee, CML Healthcare, Inc. The erroneous payments were made in good faith by Patentees, and are being corrected promptly after discovery by Patentees of the apparent loss of small entity status.

Accordingly, Patentees submit this paper to update their status and pay the deficiency owed for fees erroneously paid at the small entity rate since May 22, 2003. The following table shows the erroneous fee(s) paid at the small entity rate that should have been paid at the large entity rate, the current fee(s) for the same transaction(s), and the deficiency owed (i.e., the difference between the erroneous fee(s) and the current fee(s)).

| Erroneous Fee | | | Current Fee | Deficiency Owed |
|-----------------|----------|----------|-------------|-----------------|
| Type | Date | Amount | | |
| Maintenance Fee | 05-28-03 | \$445.00 | \$940.00 | \$495.00 |

Authorization is hereby provided to charge our Account No. 03-0075 in the amount of \$495.00 to cover the deficiency owed. The Office is also authorized to charge any additional fees related to this matter (including the processing fee of 37 CFR § 1.17(i), if required) to that Account. A duplicate copy of this entity status correction is provided.

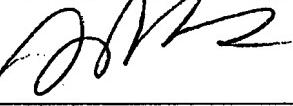
Application No. 09/083,410
Correction of Small Entity Status Dated December 1, 2004

It is understood that this paper will also act as a notification of loss of status pursuant to 37 CFR § 1.28(d). Issuance of a paper acknowledging this updated information is respectfully requested.

Should there be any questions or concerns regarding this matter, please contact the undersigned at the telephone number listed below.

Respectfully submitted,

CAESAR, RIVISE, BERNSTEIN,
COHEN & POKOTILOW, LTD.

By 

David M. Tener
Registration No. 37,054
Customer No. 03000
(215) 567-2010
Attorneys for Patentee(s)

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OFFICE OF PETITIONS

December 1, 2004

Please charge or credit our
Account No. 03-0075 as necessary
to effect entry and/or ensure
consideration of this submission.

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing CORRECTION OF SMALL ENTITY STATUS UNDER 37 CFR 1.28(c) in duplicate re U.S. Patent No. 6,046,004 (Application Serial No. 09/083,410) is being facsimile transmitted to the U.S. Patent and Trademark Office, Maintenance Fee Branch, Office of Finance at (703) 308-5077 addressed to: Mail Stop M Correspondence, Director of the U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450, this 1st day of December, 2004.



David M. Tener